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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/004,420	01/08/98	RICHTER	J 260048601

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EXAMINER

CARTER, R

ART UNIT

PAPER NUMBER

3736

*12*

DATE MAILED:

08/14/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/004,420

Applicant(s)

Richter et al.

Examiner

Ryan Carter

Group Art Unit

3736



☒ Responsive to communication(s) filed on Jul 3, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1035 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

## Disposition of Claim

☒ Claim(s) 1-75 is/are pending in the application

Of the above, claim(s) 20-23 and 41-69 is/are withdrawn from consideration

☒ Claim(s) 19 is/are allowed.

☒ Claim(s) 1-4, 11-14, 24-32, 35-40, 70, and 72-75 is/are rejected.

☒ Claim(s) 5-10, 15-18, 33, 34, and 71 is/are objected to.

☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some\* ☒ None of the CERTIFIED copies of the priority documents have been

☐ received.

☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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## DETAILED ACTION

### *Election/Restriction*

1. Claims 20-23 and 41-69 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in Paper No. 8.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

3. Claims 1-4,11-14,24-32,35-38,70, and 72-75 are rejected under 35 U.S.C. 102(e) as being anticipated by Cimoichowski et al. With respect to claims 1-4,11-14,24,26-29,31,35-38,70, and 72-75, Cimoichowski et al. disclose an endoluminal implant comprising a fixation device (stent) and atleast one sensor placed onto a sensor support (solder) for coupling to the stent. The solder has a surface for receiving the sensor. The implant is inserted into the body, and is also secured to the body, for example "...with metal hooks to firmly attach the graft to the vessel

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wall.” The implant may also be expanded for fixation in the vessel. (See, e.g., Col.25, lns.33-40 and 50-60)

With respect to claim 25,30, and 32, Cimochoowski et al. disclose an endoluminal implant comprising a stent and a sensor placed into a sensor support (226) which couples the sensor to the stent by coating. The implant is inserted into the body, and is also secured to the body, for example “...with metal hooks to firmly attach the graft to the vessel wall.” (Col.25, lns.35-40)

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 39-40 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cimochoowski et al. Cimochoowski discloses the use of hooks or a balloon to couple the device to the vessel. It would have been obvious to one skilled in the art to use such known materials as glue or sutures, to provide a mere alternative means for coupling the device to the vessel.

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*Allowable Subject Matter*

6. Claims 5-10,15-18,33-34 and 71 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
7. Claim 19 is allowed.

*Response to Arguments*

8. Applicant's arguments filed July 3, 2000 have been fully considered but they are not persuasive. Applicant has argued that Cimochoowski et al. does not disclose the claimed subject matter of the present invention. In response, the Examiner has attempted to be more specific in pointing out how he feels many of the present claims are not novel, in view of Cimochoowski. Particularly, Applicant has argued that the prior art doesn't disclose a sensor support for receiving the sensor. As pointed out in the above rejection, the sensor support can be seen as the solder (228). Thus, it is clear that contrary to the Applicant's assertion, the sensor is not directly mounted to the stent itself. There is indeed an intermediate element between the sensor and stent (please see Figure 19).

Furthermore, Applicant has argued that Cimochoowski does not show a sensor that is couled to the bodily lumen itself. In strong response to this argument, Cimochoowski very clearly specifies the use of hooks to attach the stent to the vessel wall.

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The Examiner has deemed the Applicant's remarks with respect to claim 19 compelling, and accordingly has allowed the claim.

*Conclusion*

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ryan Carter whose telephone number is (703) 308-2990.

rcc

August 9, 2000

*Cary O'Connor*  
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GROUP 3700